

## Remarks

The Office Action mailed June 12, 2007, has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Applicants believe that no extension of term is required and that no additional fee for claims is required. If any additional fee is required for an extension of term or claims, the Commissioner is hereby authorized to charge Deposit Account No. 01-2384.

Claims 13-40 are now pending in this application. Claims 13-40 and 46-48 stand rejected. Claims 1-12 and 41-48 have been cancelled.

The rejection of Claims 13-40 and 46-48 under 35 U.S.C. § 103 as being unpatentable over Jonstromer (US 6,142,369) in view of Falk et al. (US 5,668,876) is respectfully traversed.

Jonstromer describes at Col. 4, lines 20-44 cash transactions to be initiated with a smart card, which holds cash credits and acts as an electronic wallet, inserted into the mobile phone, and the user enters his PIN and a phone number for the payee's electronic till (4), together with an amount to be transferred, by means of the mobile phone's keypad. The smart card deducts the amount entered from the total credit held on the smart card and formulates a signal for transmission by the mobile phone to electronic till (2). The signal transmitted by mobile telephone (4), to electronic till (2), may include an electronic signature encoded by means of an asymmetric cypher and key, which uniquely and securely identifies the smart card. Notably, Jonstromer does not describe nor suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver.

Falk et al. describes at Col. 6, lines 3-12, and Fig. 1, a closed loop process where a personal unit user initiates communication to a service node (26) via the service access network (24). This can be as simple as picking up the telephone and dialing an appropriate telephone number, which may be pre-stored in the personal unit (20). At step S12, the process may include entering a user number or identity, such as used for a data service. As shown at step S14, the service access network (24) transparently communicates an access request from the user to the

service node (26). Notably, Falk et al. does not describe nor suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver.

Independent Claim 13 recites a method for digital signing of a message which is transmitted via a communication network to a signing unit, comprising: "initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver; transmitting the message to be signed from the first receiver via a telephone network to the mobile radio telephone comprising a signing unit, the telephone network comprising a mobile radio telephone network, the mobile radio telephone associated with the telephone network; signing the message to be signed via the mobile radio telephone, thereby forming a signed message, the signed message signifying a user's intent to deliver the signed message and its content; transmitting the signed message to the first receiver or at least one other receiver; and communicating the signed message to an addressee."

Applicants respectfully submit that neither Jonstromer nor Falk et al., nor the combination of the two, describe or suggest the claimed invention. As discussed below, neither Jonstromer nor Falk et al. describe or suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver. Rather, and in contrast to the present invention, Jonstromer describes a smart card, which holds cash credits and acts as an electronic wallet, inserted into the mobile phone, and the user enters his PIN and a phone number for the payee's electronic till, together with an amount to be transferred, by means of the mobile phone's keypad. The signal transmitted by mobile telephone, to electronic till, may include an electronic signature encoded by means of an asymmetric cypher and key, which uniquely and securely identifies the smart card. Although Jonstromer describes a signal transmitted by mobile telephone, Jonstromer does not describe nor suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver.

In addition, Falk et al. describes a closed loop process where a personal unit user initiates communication to a service node via the service access network. This can be as simple as

picking up the telephone and dialing an appropriate telephone number, which may be pre-stored in the personal unit. As shown at step S14, the service access network transparently communicates an access request from the user to the service node. Moreover, Falk et al. explicitly requires that communication must be initiated from the personal unit itself. Falk et al. does not describe nor suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver.

For all of the reasons set forth above, Claim 13 is submitted to be patentable over Jonstromer in view of Falk et al.

Claims 14-21 depend, directly or indirectly, from independent Claim 13. When the recitations of Claims 14-21 are considered in combination with the recitations of Claim 13, Applicants submit that dependent Claims 14-21 likewise are patentable over Jonstromer in view of Falk et al.

Independent Claim 22 recites "a method for digitally signing, by means of a signing apparatus, a message to be transmitted to a receiving device, characterized in that the message to be signed is initiated to be transmitted from a transmitting device external to a network, the network including the receiving device and the signing apparatus, to the receiving device, this message is then transmitted from the receiving device via a telephone network to the signing apparatus associated with the transmitting device, this message is then signed in the signing apparatus and transmitted back to the receiving device as a signed message."

Applicants respectfully submit that neither of Jonstromer or Falk et al., nor the combination of the two, describe or suggest the claimed invention. More specifically, neither Jonstromer nor Falk et al. describe or suggest a message to be transmitted to a receiving device, characterized in that the message to be signed is initiated to be transmitted from a transmitting device external to a network, the network including the receiving device and the signing apparatus, to the receiving device. Rather in contrast to the present invention, Jonstromer describes a smart card, which holds cash credits and acts as an electronic wallet, inserted into the mobile phone, and the user enters his PIN and a phone number for the payee's electronic till,

together with an amount to be transferred, by means of the mobile phone's keypad. The signal transmitted by mobile telephone, to electronic till, may include an electronic signature encoded by means of an asymmetric cypher and key, which uniquely and securely identifies the smart card. Although Jonstromer describes signal transmission, Jonstromer does not describe nor suggest a message to be transmitted to a receiving device, characterized in that the message to be signed is initiated to be transmitted from a transmitting device external to a network, the network including the receiving device and the signing apparatus, to the receiving device.

In addition, Falk et al. describes a closed loop process where a personal unit user initiates communication to a service node via the service access network. This can be as simple as picking up the telephone and dialing an appropriate telephone number, which may be pre-stored in the personal unit. As shown at step S14, the service access network transparently communicates an access request from the user to the service node. Moreover, Falk et al. explicitly requires that communication must be initiated from the personal unit itself. Falk et al. does not describe nor suggest a message to be transmitted to a receiving device, characterized in that the message to be signed is initiated to be transmitted from a transmitting device external to a network, the network including the receiving device and the signing apparatus, to the receiving device.

For all of the reasons set forth above, Claim 22 is submitted to be patentable over Jonstromer in view of Falk et al.

Claims 23-32 depend, directly or indirectly, from independent Claim 22. When the recitations of Claims 23-32 are considered in combination with the recitations of Claim 22, Applicants submit that dependent Claims 23-32 likewise are patentable over Jonstromer in view of Falk et al.

Independent Claim 33 recites "a chip card for a mobile telephone, wherein the chip card incorporates a signing device which has a memory unit for storing a private key necessary for producing a signed message, characterized in that the signing device generates the signed message from a message to be signed, which is initiated from a transmitter external to a network,

the network including a first receiver and the mobile telephone, which is received by the mobile telephone via a telephone network.”

Applicants respectfully submit that neither of Jonstromer or Falk et al., nor the combination of the two, describe or suggest the claimed invention. Specifically, neither Jonstromer nor Falk et al. describe or suggest a signing device that generates the signed message from a message to be signed, which is initiated from a transmitter external to a network, the network including a first receiver and the mobile telephone, which is received by the mobile telephone via a telephone network. Rather, and in contrast to the present invention, Jonstromer describes a smart card, which holds cash credits and acts as an electronic wallet, inserted into the mobile phone, and the user enters his PIN and a phone number for the payee's electronic till, together with an amount to be transferred, by means of the mobile phone's keypad. The signal transmitted by mobile telephone, to electronic till, may include an electronic signature encoded by means of an asymmetric cypher and key, which uniquely and securely identifies the smart card. Although Jonstromer describes an electronic card which may be inserted into a mobile phone, Jonstromer does not describe nor suggest a signing device that generates the signed message from a message to be signed, which is initiated from a transmitter external to a network, the network including a first receiver and the mobile telephone, which is received by the mobile telephone via a telephone network.

In addition, Falk et al. describes a closed loop process where a personal unit user initiates communication to a service node via the service access network. This can be as simple as picking up the telephone and dialing an appropriate telephone number, which may be pre-stored in the personal unit. As shown at step S14, the service access network transparently communicates an access request from the user to the service node. Moreover, Falk et al. explicitly requires that communication must be initiated from the personal unit itself. Falk et al. does not describe nor suggest a signing device that generates the signed message from a message to be signed, which is initiated from a transmitter external to a network, the network including a first receiver and the mobile telephone, which is received by the mobile telephone via a telephone network.

For all of the reasons set forth above, Claim 33 is submitted to be patentable over Jonstromer in view of Falk et al.

Independent Claim 34 recites a method for transport via a communication network of a message to a mobile phone and transport of a corresponding signed message, said method comprising: "initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver; transmitting the message to be signed from the first receiver via a telephone network to the mobile radio telephone whereat the message to be signed may be signed, and when signed, generates a corresponding signed message; transmitting the corresponding signed message from the mobile radio telephone to the first receiver or at least one other receiver; and communicating the corresponding signed message to an addressee."

Applicants respectfully submit that neither of Jonstromer or Falk et al., nor the combination of the two, describe or suggest the claimed invention. As discussed below, neither Jonstromer nor Falk et al. describe or suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver. Rather in contrast to the present invention, Jonstromer describes a smart card, which holds cash credits and acts as an electronic wallet, inserted into the mobile phone, and the user enters his PIN and a phone number for the payee's electronic till, together with an amount to be transferred, by means of the mobile phone's keypad. The signal transmitted by mobile telephone, to electronic till, may include an electronic signature encoded by means of an asymmetric cypher and key, which uniquely and securely identifies the smart card. Although Jonstromer describes a signal transmitted by mobile telephone, Jonstromer does not describe nor suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver.

In addition, Falk et al. describes a closed loop process where a personal unit user initiates communication to a service node via the service access network. This can be as simple as picking up the telephone and dialing an appropriate telephone number, which may be pre-stored in the personal unit. As shown at step S14, the service access network transparently communicates an access request from the user to the service node. Moreover, Falk et al.

explicitly requires that communication must be initiated from the personal unit itself. Falk et al. does not describe nor suggest initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver.

For all of the reasons set forth above, Claim 34 is submitted to be patentable over Jonstromer in view of Falk et al.

Claims 35-38 depend, directly or indirectly, from independent Claim 34. When the recitations of Claims 35-38 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 35-38 likewise are patentable over Jonstromer in view of Falk et al.

Independent Claim 39 recites a method, comprising: "a mobile radio telephone user receiving a message from a telephone network, the message being initiated from a transmitter external to a network, the network including a first receiver and a mobile radio telephone; the user using the mobile radio telephone to generate a signed message corresponding to the received message; and the user initiating transmission of the signed message via the use of the mobile radio telephone into the telephone network so as to communicate the signed message to an addressee."

Applicants respectfully submit that neither of Jonstromer or Falk et al., nor the combination of the two, describe or suggest the claimed invention. Specifically, neither Jonstromer nor Falk et al. describe or suggest a mobile radio telephone user receiving a message from a telephone network, the message being initiated from a transmitter external to a network, the network including a first receiver and a mobile radio telephone. Rather in contrast to the present invention, Jonstromer describes a smart card, which holds cash credits and acts as an electronic wallet, inserted into the mobile phone, and the user enters his PIN and a phone number for the payee's electronic till, together with an amount to be transferred, by means of the mobile phone's keypad. The signal transmitted by mobile telephone, to electronic till, may include an electronic signature encoded by means of an asymmetric cypher and key, which uniquely and securely identifies the smart card. Although Jonstromer describes a signal transmitted by mobile

telephone, Jonstromer does not describe nor suggest a mobile radio telephone user receiving a message from a telephone network, the message being initiated from a transmitter external to a network, the network including a first receiver and a mobile radio telephone.

In addition, Falk et al. describes a closed loop process where a personal unit user initiates communication to a service node via the service access network. This can be as simple as picking up the telephone and dialing an appropriate telephone number, which may be pre-stored in the personal unit. As shown at step S14, the service access network transparently communicates an access request from the user to the service node. Moreover, Falk et al. explicitly requires that communication must be initiated from the personal unit itself. Falk et al. does not describe nor suggest a mobile radio telephone user receiving a message from a telephone network, the message being initiated from a transmitter external to a network, the network including a first receiver and a mobile radio telephone.

For all of the reasons set forth above, Claim 39 is submitted to be patentable over Jonstromer in view of Falk et al.

Claim 40 depends directly from independent Claim 39. When the recitations of Claim 40 are considered in combination with the recitations of Claim 39, Applicants submit that dependent Claim 40 likewise is patentable over Jonstromer in view of Falk et al.

Claims 46-48 have been canceled.

Notwithstanding the above, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection and that the presently claimed invention is not obvious in light of Jonstromer in view of Falk et al. Specifically, the Office Action only offers the conclusory statement that "it is proper to combine the references to securely conducting electronic services." The United States Supreme Court has recently held that obviousness rejections must be supported with "articulated reasoning with some rational underpinning to support the conclusion of obviousness." See *KSR International Co. v. Teleflex, Inc.*, slip Opinion at page 14. The present rejection does not appear to meet this standard as it reflects no articulate reasoning why the independent or dependent claims are believed to be obvious, but rather is stated in the form of a conclusion of obviousness. Applicant accordingly

requests specific explanation and articulation regarding the reasoning and rational underpinning for any obviousness rejection of the claims. It is not believed that adequate reasons why the presently claimed invention is believed to be obvious have been provided on the present record.

It appears that the present rejection reflects an impermissible attempt to use the instant claims as a guide or roadmap in formulating the rejection using impermissible hindsight reconstruction of the invention. The United States Supreme Court has recently expressed concern regarding distortion caused by hindsight bias in an obviousness analysis, and notes that factfinders should be cautious of arguments reliant upon ex post reasoning. See *KSR International Co. v. Teleflex, Inc.*, slip Opinion at page 17.

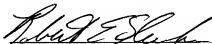
In addition, if art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Applicants respectfully submit Falk et al. teaches away from the present invention. More specifically, Falk et al. explicitly requires that communication must be initiated from the personal unit itself. Falk et al. do not describe nor suggest receiving a message to be signed, the message being initiated from a transmitter external to a network, the network including a first receiver and the wireless device. Jonstromer does not make up for the deficiencies of Falk et al.

Furthermore, Applicants respectfully submit that neither Jonstromer nor Falk et al. describe or suggest an apparatus or method that includes initiating a transmission from a transmitter external to a network, the network including a first receiver and a mobile radio telephone, a message to be signed to the first receiver, signing the message to generate a corresponding signed message, and transmitting the corresponding signed message to one or more receivers. Accordingly, Claims 13-40 are submitted to be patentable over Jonstromer in view of Falk et al.

For all of the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 13-40 and 46-48 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Robert E. Slenker

Registration No. 45,112

ARMSTRONG TEASDALE LLP

One Metropolitan Square, Suite 2600

St. Louis, Missouri 63102-2740

(314) 621-5070